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Reto Sieber

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New York, NY 10168

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EXAMINER

CHANG, VICTOR S

ART UNIT

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1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/762,530	Applicant(s) SIEBER ET AL.	
	Examiner Victor S. Chang	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 16-19 and 22-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 16-19 and 22-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. Applicants' amendments and remarks filed on 12/14/2007 have been entered. Claims 11, 27 and 32 have been amended. Claim 21 has been cancelled. New claims 33-37 have been entered. Claims 11, 16-19 and 22-37 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Claim Objections

4. Claims 11, 16-19 and 22-37 are objected to because of the following informalities:

In claims 11, 27 and 32, the phrase "coated ... surface being planar" is incommensurate with the disclosed coating surface feature "substantially planar" throughout the original specification. Appropriate correction is required.

Claim 18 compares the "pressure-sensitive adhesive" of "first pressure-sensitive adhesive coating" to the "pressure-sensitive adhesive coating" of "second pressure-sensitive adhesive coating.". It is uncertain whether the composition or the coating pattern being compared. For the present Office action, since claim 11 recites first and second adhesive patterns, it is presumed that the adhesive patterns are being compared. Clarification is required in the next reply.

Claim 25 depends on cancelled claim 21. Since the limitation of cancelled claim 21 has been incorporated in claim 11, it is presumed that claim 25 depends on claim 11. Similarly, claim 26 is presumed to be dependent upon claim 11. Corrections are required.

Claim Rejections - 35 USC § 112

5. Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, newly added claim 37 recites “said first pattern is on the entire top surface of said backing layer.” However, the limitation “entire top surface” appears to be new matter, because no support can be found in the original specification. Applicants must cancel new matter, or provide a clear support in the next reply.

Rejections Based on Prior Art

6. Claims 11, 16-19, 22-29, 31-35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal [GB 2063710].

Marchal relates to an adhesive tape for fixing a floor covering or carpet to a floor [pp. 1, ll. 5-6]. The adhesive sheet is sticky on both sides. One surface is more powerfully adhesive than the other side. The different surface adhesive strength affords multiple advantages for the covering in use, and for positioning and removal [pp. 1, ll. 116-130]. Figs. 1-3 illustrate various embodiments to obtain the different surface adhesive strength. For example, Fig. 3 shows an

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embodiment of a support 11 being completely (entirely) covered by a glue layer 11B, and a less sticky glue layer 11A, formed in the form of strips or points, on the opposite surface [pp. 2, ll. 74-75 and 100-104]. The tape is fixed more firmly to the back of the covering than to the receiving floor surface [pp. 2, ll. 110-115]. The layer 11 may be a sheet of textile which may or may not be treated to make it impermeable or it may be a continuous sheet made of a synthetic material [pp. 2, ll. 116-119]. The adhesive layer may consist of a weave of intersecting threads on which a glue is applied [pp. 2, ll. 31-33].

For claims 11 and 25-28, the coated surface feature “planar” is interpreted as “substantially planar”, and read upon by Marchal, because Marchal teaches the same end use, which would obviously require similar adhesive surface for the same use. The phrase “that is the same as the first pattern on the bottom surface of said backing layer” is interpreted as meaning “a second pressure-sensitive adhesive coating coated in a second pattern”, i.e., both surfaces are coated with adhesive patterns. Marchal is silent about the minimum width of the sheet. However, a workable width is deemed to be an obvious routine optimization to one of ordinary skill in the art of adhesive tapes for floor covering, because the same end use would have dictated similar expected beneficiary effects by a workable tape width.

For claims 16-19 and 22-24, Marchal is silent about the adhesive strengths and amount of adhesive per unit area of the adhesive layers. However Marchal teaches an adhesive tape having different surface adhesive strengths for the same application, and teaches different patterns results in different contact area for different adhesive strengths, workable adhesive strengths and amount of adhesive per unit area of the adhesive layers are deemed to be obvious routine optimization to one of ordinary skill in the art of adhesive tapes for various floor coverings.

For claim 29, Marchal's teaching of fixing a floor covering by an adhesive tape to a wood floor clearly encompasses a floor of parquet [pp. 1, ll. 86].

For claims 31 and 32, since Marchal teaches that the adhesive layer may consist of a weave of intersecting threads (textile or threaded mesh) on which a glue is applied, it would have been obvious to one of ordinary skill in the art to in that art to incorporate the intersecting treads in top and/or bottom adhesive layers, motivated by the desire to obtain a beneficial effects, such as an improved dimensional stability.

For claims 33-35 and 37, Marchal's Figs. 1-3 illustrate that the whole (entire) top and bottom surfaces are covered with adhesive coating patterns. They inherently have equivalent surface areas, because the two surfaces are clearly coextensive.

7. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal in view of Su [US 5462782].

The teachings of Marchal are again relied upon as set forth above.

For claim 30, Marchal teaches that backing layer 11 may be a continuous sheet made of a synthetic material. Marchal is silent about the synthetic material being polyethylene. However, Su teaches a double sided adhesive tape comprising a backing layer of polyethylene [abstract] to provide for strength to the tape. It would have been obvious to one having ordinary skill in the art to select a polyethylene film to make Marchal's adhesive tape, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

8. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal in view of Plumly [US 5363579].

The teachings of Marchal are again relied upon as set forth above.

For claim 36, Marchal teaches a double sided adhesive tape for fixing floor covering to floor. One surface is more powerfully adhesive than the other side. The different surface adhesive strength affords multiple advantages for the covering in use, and for positioning and removal. Marchal is silent about forming the differential adhesive strengths by applying adhesives having different adhesive strengths. However, Plumly's invention relates to a floor type advertising apparatus. Fig. 29 shows an embodiment employing a differential adhesive tape to removably hold the transparent layer in place for removably receiving an advertising layer [col. 13, ll. 10-13 and 64]. The differential adhesive tape is a high tack/medium tack double coated film tape. The medium tack side can be secured to a receiving surface and removed a number of times without leaving a residue [col. 14, ll. 1-8]. It would have been obvious to one of ordinary skill in the art to form Marchal's adhesive tape with the differential adhesives taught by Plumly, because the substitution of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

Response to Arguments

9. Applicants argue at Remarks page 12 that

“In regard to claims 11, 27 and 32, Marchal does not disclose first and second adhesive coatings with the same pattern. If a first and a second adhesive coating on a self-adhesive sheet have the same pattern then they must have the same surface area.”

However, the claim language fails to recite the coatings have the same pattern, as set forth above.

Regarding the coated surface area, it is interpreted as meaning areas being covered by adhesive pattern, including area which is included in the pattern, but free of adhesive. The claim language

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fails to exclude uncoated area within the adhesive pattern. Since both backing surfaces are wholly covered with adhesive pattern, and the backing surfaces are coextensive, Marchal anticipates the claimed features.

Applicants argue at page 14 that

“the Examiner should consider the process conditions when assessing the patentability of claims 17, 19 and 24 or otherwise allow the claims.”

However, a careful review shows that claims 17, 19 and 24 do not contain product-by-process languages.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794